

CLELAND et al. -- 10/686,816
 Attorney Docket: 050017-0305220

REMARKS

Claims 1-19 are pending. By this Amendment, the specification is amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Claims 1-19 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-28 of U.S. Patent 6,719,356 in view of Schuttler (U.S. Patent 5,450,933). The rejection is respectfully traversed.

MPEP §804II.B.1. sets forth the requirements for establishing a *prima facie* case of obviousness-type double patenting. This section of the MPEP clearly sets forth that the requirement for establishing a *prima facie* case of obviousness-type double patenting parallels the guidelines for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a). The factual inquiries for determining obviousness-type double patenting include: (A) determining the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (B) determining the differences between the scope and content of the patented claim and the prior art as determined in (A) and the claim in the application at issue; (C) determining the level of ordinary skill in the pertinent art; and (D) evaluating any objective indicia of nonobviousness.

This section of the MPEP further states that any obviousness-type double patenting rejection should make clear: (A) the differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent.

It is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting. In particular, it is respectfully submitted that the Examiner has not identified any differences between the inventions defined in claims 1-19 in the instant application and claims 1-28 of U.S. Patent 6,719,356. In addition, it is respectfully submitted that the Examiner has not provided any reasons why one of ordinary skill in the art would conclude that the inventions defined in claims 1-19 of the instant application would have been an obvious variation of the invention defined in claims 1-28 of U.S. Patent 6,719,356.

With respect to the allegation on page 2, paragraph number 2, of the Office Action that "U.S. Patent No. 6,719,356 discloses a powered closure drive mechanism for a vehicle,"

CLELAND et al. -- 10/686,816
Attorney Docket: 050017-0305220

it is respectfully noted that the MPEP section discussed above clearly states that when considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in claim of a patent, the disclosure of the patent may be used as prior art. Accordingly, it is respectfully submitted that the Examiner's reliance on the disclosure of U.S. Patent 6,719,356 for the determination that claims 1-19 are obvious in view of claims 1-28 of U.S. Patent 6,719,356 is clearly contrary to Patent Office policy and fails to establish a *prima facie* case of obviousness-type double patenting.

Reconsideration and withdrawal of the rejection of claims 1-19 over claims 1-28 of U.S. Patent 6,719,356 in view of Schuttler are respectfully requested.

Claims 1 and 10 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of co-pending U.S. Application 10/674,004 (which was published as U.S. Patent Application Publication 2004/0124662 A1). The rejection is respectfully traversed.

The Office Action on page 2, paragraph number 3, acknowledges that the claims of U.S. Application 10/674,004 do not recite a dynamic property detector. The Examiner concludes, however, that the controller of the claims of U.S. Application 10/674,004 must get input from something and then takes Official Notice that it is well-known in the art to use dynamic property detectors as inputs in a controller.

It is respectfully submitted that the use of dynamic property detectors as inputs to a controller, including the use of dynamic property detectors as recited in the pending claims, is not a fact that is well-known and capable of instant and unquestionable demonstration as being well-known. Accordingly, and in accordance with MPEP §2144.03, Applicants respectfully request that the Examiner provide documentary evidence in the next Office Action that supports the Examiner's position that the use of dynamic property detectors as inputs to a controller is well-known in the art. In the absence of such documentary evidence, it is respectfully submitted that the rejection fails to present a *prima facie* case of obviousness-type double patenting and must be withdrawn.

With respect to the Examiner's determination that the claimed method of operating a vehicle door would have been inherent to the vehicle door with the strut, it is respectfully noted that MPEP §2112 states that in order to rely upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied prior art. In addition, it is respectfully noted that MPEP §2112.02 states that

CLELAND et al. -- 10/686,816
Attorney Docket: 050017-0305220

when the prior art device is the same as the device described in the specification for carrying out the claimed method, it can be assumed that the device will inherently perform the claimed process. However, as admitted by the Examiner, the device of claim 8 of U.S. Application 10/674,004 is different, not the same, as the device of the pending claims. Accordingly, it is respectfully submitted that the claimed method is not inherent from claim 8 of U.S. Application 10/674,004.

Reconsideration and withdrawal of the rejection of claims 1 and 10 over claim 8 of U.S. Application 10/674,004 are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP


JOHN P. DARLING
Reg. No. 44482
Tel. No. (703) 905-2045

Date: August 29, 2005

P.O. Box 10500
McLean, VA 22102

Tel. No. (703) 905-2000
Fax No. (703) 905-2500